

REMARKS/ARGUMENTS

Claims 1-26 are pending in this patent application.

As a preliminary matter, Applicants wish to thank the Examiner for discussing with Jeffrey H. Rosedale the location of the after final submissions filed on July 31, 2003 in response to the February 3, 2003 Office Action. Applicants wish to note for the record that the Examiner had indicated that the 131 Declaration, Extension of Time, Notice of Appeal, and Power of Attorney were in the file, but that Applicant's Reply Pursuant to 37 CFR § 1.116 was not in the file. As a courtesy, Applicants provide herewith a copy of their previous Reply and the date-stamped postcard that indicates that the Reply was also received by the Patent Office on July 31, 2003. Applicants' remarks from their earlier reply are repeated below in items **II** and **III**.

I. Reduction to Practice of the Fluorescence Mode

The Advisory Action dated September 18, 2003 alleges that the Rule 131 declaration filed on July 31, 2003 does not overcome the prior rejections based on U.S. Patent No. 6,124,594A to Duggan *et al.* ("the Duggan patent") because it is silent as to Applicants' earlier reduction to practice of the fluorescence mode. Applicants respectfully submit that this declaration is entirely sufficient because the Duggan patent does not disclose, teach or suggest the use of fluorescence in any way. Indeed, the Duggan patent only describes the use of an infrared source and an infrared detector for detecting contact lenses by **infrared absorption** (col. 2, lines 8-31), which Applicants' declaration clearly addresses.

II. Rejections under 35 U.S.C. §§ 102 and 103 over the Duggan Patent

Claims 1, 2, 4, 10, 11, 12, 15, 26, 17, 19, 20 and 22 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by the Duggan patent. Also, claims 5-7, 9, 13, 14 and 16 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable for obviousness in view of the Duggan patent. However, since the Rule 131 Declaration of Timothy P. Newton provided July 31, 2003 demonstrates that Applicants' invention was conceived and reduced to practice prior to the filing date of the Duggan patent, that patent is not "a patent granted on an application for patent by another filed in the United States before the invention by the

DOCKET NO.: VTN-0564-US
Application N .: 09/819,074
Office Action Dated: September 18, 2003

**PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116**

applicant for patent,” and thus does not constitute prior art under 35 U.S.C. § 102(e). Accordingly, Applicants respectfully request that the 35 U.S.C. § 102 and 103 rejections based on the Duggan patent be withdrawn.

III. Double Patenting Rejections

Claims 1-12, 23, 24 and 13-22 stand rejected under 35 U.S.C. § 101 for statutory type double patenting as being allegedly unpatentable over claims 1-24 of prior U.S. Patent No. 6,246,062. Pursuant to the Decision Granting Petition mailed on October 12, 2001, in connection with both the instant patent application and parent application 09/187,579, Applicants will address this rejection in due course, upon the indication of otherwise allowable subject matter in the instant application. Accordingly, upon the Office’s removal of the Duggan patent as prior art in view of the Rule 131 Newton declaration, and in view of the Duggan patent not disclosing fluorescence, Applicants will consider canceling claims 1-12, 23, 24 and 13-22 of the instant application.

Claims 25 and 26 stand rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 8 and 4 of U.S. Patent No. 6,246,062. Applicants request that this rejection be deferred pending some identification of allowable subject matter, as it likely can be resolved (depending upon the subject matter ultimately allowed) through the filing of a suitable terminal disclaimer.

IV. Conclusions

Applicants request the Examiner to:

- (1) consider the Rule 131 declaration of Newton provided on July 31, 2003;
- (2) withdraw the Duggan patent as prior art so that only the statutory double patenting rejection of claims 1-24 remain pursuant to the Decision Granting Petition mailed October 12, 2001, upon which Applicants will consider canceling claims 1-24; and
- (3) reconsider and withdraw the standing rejections of claims 25 and 26.

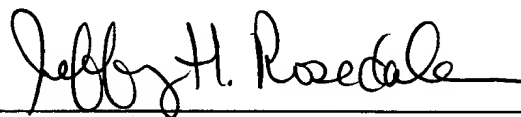
DOCKET NO.: VTN-0564-US
Application No.: 09/819,074
Office Action Dated: September 18, 2003

PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116

If the Examiner is of contrary view, the Examiner is requested to contact the undersigned attorney at (215) 557-5984.

Respectfully submitted,

Date: October 31, 2003



Jeffrey H. Rosedale
Registration No. 46,018

Please continue to direct correspondence to

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003